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**REMARKS**

**I. Status of the Claims**

Claims 18-28 and 30-51 are pending in this application. Claim 19 was canceled. Independent claims 18, 47, 49, and 50 were amended to include the limitations recited in claim 19 and to specifically recite the group of acyl derivatives that the at least one of an opacifier and a pearlescent is chosen from . Dependent claims 20-22 and 25 were amended to correct their dependency due to the cancellation of claim 19. Support for these amendments can be found in the claims as originally filed. These amendments raise no issue of new matter and Applicants respectfully request their entry.

**II. Finality of the Office Action**

The Examiner made this Office Action final alleging the new ground of rejection was necessitated by Applicant's amendment. Office Action at page 6. Applicants respectfully submit that the finality of this Office Action is premature.

In the previous Office Action, the Examiner did not reject claim 29 under 35 U.S.C. § 102. See Office Action dated March 27, 2003 at pages 2-3. In the Response filed July 28, 2003, Applicants amended independent claim 18 by adding the limitations of claim 29, thereby rendering moot the rejection. In the present Office Action, the Examiner states "claim 29 was inadvertently omitted from the § 102 rejections in the previous Office action," but that "the finality of the present Office Action is proper since the instant rejections under § 102 are made in response to applicant's claim amendment." Office Action at page 2.

It is clear that this rejection of claim 29 is a new ground of rejection. The Examiner may make an action which introduces a new ground of rejection final only

where the new ground of rejection is necessitated by an applicant's amendment of the claims or based on information submitted in an information disclosure statement. See M.P.E.P. § 706.07(a). Contrary to the Examiner's assertion, the rejection of claim 18 was not necessitated by Applicant's amendment since the limitations of non-rejected claim 29 were in no way altered when added to claim 18 in the Amendment filed July 28, 2003. Indeed, the fact that the Examiner asserts that the rejection was inadvertently omitted in the previous action illustrates that the Examiner intended to issue the rejection *before* Applicant's amendment.

Accordingly, Applicants request that the finality of the Office Action dated November 4, 2003 be withdrawn.

### **III. Rejections Under 35 U.S.C. § 102**

#### **A. Tian et al.**

The Examiner rejected claims 18, 32-35, 40-45, 47, and 49-51 under 35 U.S.C. § 102(a) as allegedly being anticipated by Tian et al. (WO 99/13844) ("Tian") for the same reasons as in the previous Office Action. Office Action at page 2. Applicants traverse this rejection.

Applicants respectfully submit that this rejection has been rendered moot by the foregoing amendments incorporating subject matter of claim 19, which was not rejected by the Examiner, into the independent claims.

Accordingly, for at least this reason, the rejection under § 102(a) has been overcome and should be withdrawn.

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**B. Asmus et al.**

Claims 18, 32-35, 40, 42-45, 47, and 50 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Asmus et al. (WO 97/00668) ("Asmus"). Office Action at page 3. Applicants respectfully traverse this rejection for the same reason as above, since claim 19 was not rejected. Accordingly, for at least this reason, Applicants respectfully request that this ground of rejection be withdrawn.

**IV. Rejections Under 35 U.S.C. § 103**

**A. Mitsumatsu et al.**

Claims 18, 26-44, and 46-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitsumatsu et al. (WO 99/13830) ("Mitsumatsu") for the same reasons as in the previous Office Action. Office Action at pages 3 and 4. Applicants respectfully traverse this rejection.

To establish a prima facie case of obviousness the Examiner has the burden to show, among other requirements, that the prior art reference or references teach or suggest all the claim limitations. M.P.E.P. § 2143. Applicants submit that this rejection has been rendered moot by the foregoing amendments because, as acknowledged by the Examiner in failing to reject claim 19, Mitsumatsu does not teach the "at least one of an opacifier and pearlescent agent" of the amended claims.

Accordingly, for at least this reason, Applicants request that this ground of rejection be withdrawn.

**B. Mitsumatsu et al. in view of Sebag et al.**

The Examiner maintained the rejection of claims 19-25 under 35 U.S.C. § 103(a) as being unpatentable over Mitsumatsu as applied to claims 18, 26-44, 46-51, and

further in view of Sebag et al. (WO 98/03155) ("Sebag") for the same reasons as in the previous Office Action. Office Action at page 5. Applicants thank the Examiner for removing the 35 U.S.C. § 103(a) rejection of claims 35 and 36.

In the Response to Arguments section of the Office Action, the Examiner asserts that "applicants' provide no reason or evidence to support the proposition" that the examiner's motivation to substitute the Mitsumatsu optical brightener with the Sebag pearlescent agent is somehow insufficient. Office Action at page 6. Applicants respectfully submit that the Examiner has misstated the burden of proof in establishing a *prima facie* case of obviousness. The M.P.E.P. requires that

[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. § 2142 at 2100-123.

Applicants submit that the factual inquiry to combine references must be thorough and searching, and must be based on objective evidence in the record. Here, the Examiner has not presented objective evidence to support the subjective, unsupported assertion of obviousness. This burden is particularly difficult in this case, considering that optical brighteners and opacifiers have different functions. Optical brighteners are used in order to alter the color of *hair* and to enhance the shine of *hair* (Mitsumatsu at page 1, lines 9-11, and page 3, lines 17-22). Opacifiers and pearlescent agents, however, are used in order to give opacity or pearlescence to the *composition*, not to the hair. The Examiner has not, and Applicants submit can not, show any motivation to substitute one for the other.

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Furthermore, the Examiner has failed to address Applicants' argument in the previous response that there is no reasonable expectation of success based on the prior art because of the importance of triazole to the Mitsumatsu invention. As Applicants explained on page 13 of the Response filed July 28, 2003, one skilled in the art reading the Mitsumatsu disclosure would realize triazole to be an essential ingredient of the Mitsumatsu invention and would not reasonably expect to successfully substitute it with another pearlescent agent.

The Examiner's inaction is clearly improper. Where "the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." M.P.E.P. § 707.07(f) at 700-113.

For at least the above reasons and the reasons of record, Applicants respectfully submit that Mitsumatsu in view of Sebag does not establish a prima facie case of obviousness. Accordingly, Applicants respectfully request that this ground of rejection be withdrawn.

## **V. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request entry of the foregoing amendments, reconsideration of this application, and timely allowance of the pending claims. If the Examiner believes a telephone call could be useful in resolving any outstanding issues, she is invited to contact Applicants' undersigned counsel at 202-408-4162.

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Please grant any extensions of time required to enter this amendment and  
charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Date: February 4, 2004

By: 

Mark D. Sweet  
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